

~~ORIGINAL~~
No. 11,991.

IN THE

United States Court of Appeals

FOR THE NINTH CIRCUIT

ALVA G. BLANCHARD,

Appellant,

vs.

J. L. PINKERTON, INC., a corporation, and J. L. PINKERTON,

Appellees.

APPELLANT'S OPENING BRIEF.

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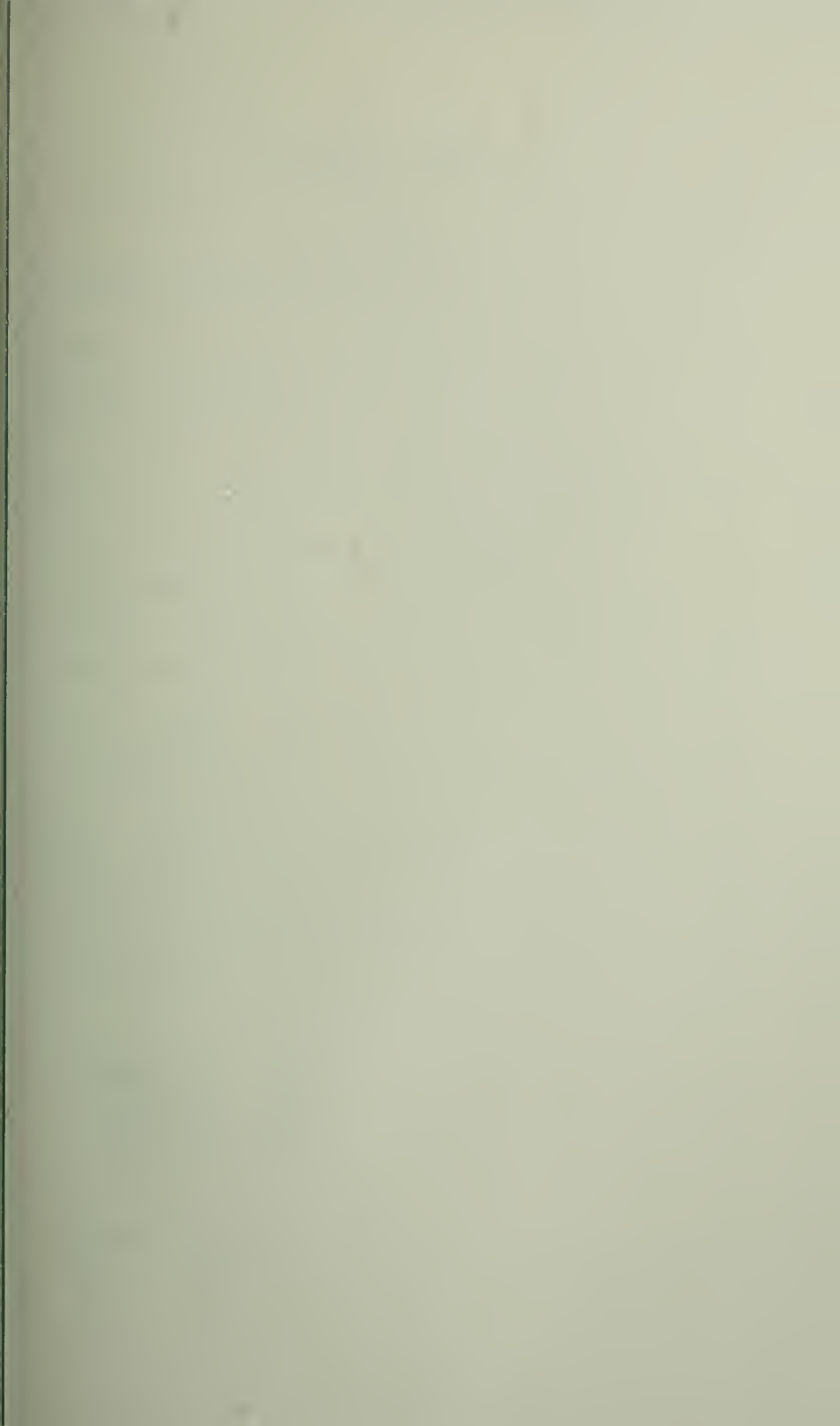
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APPELLANT'S OPENING BRIEF.

JURISDICTIONAL PLEADINGS AND FACTS.

Jurisdiction of the District Court in this case is shown by the Complaint [R. p. 2], which alleges infringement of two United States Patents, under 28 U. S. C. A. 41.

Jurisdiction of this court is shown by the Notice of Appeal [R. p. 28], which was filed within thirty (30) days after the Judgment was entered, under 28 U. S. C. A. 225.

STATEMENT OF THE CASE.

This is a patent infringement suit brought for infringement of two United States Letters Patent, numbered 2,199,611 and 2,233,395, the former being a division of the latter, which was filed in the Patent Office on October 14, 1935.

The lower court held the patents valid and found title to both of the patents in suit in the plaintiff-appellant, defendants-appellees did not cross-appeal and so validity of the patents in suit has been finally adjudicated on the merits.

However the lower court refused to hold the patents in suit infringed, and therefore appellant has prosecuted this appeal.

The principal difference between the views of appellant and of the court below is that appellant believes that the patents in suit cover valuable steps forward in the art and that as such they are entitled to the liberal construction always accorded such patents by our courts.

The court below fell into error by failing to perceive this and by erroneously trying to limit the claims in issue sufficiently to evade infringement.

The appellant submits:

1. That he is entitled to a sufficiently liberal interpretation of the claims in issue to include the appellees' accused devices.
2. That the appellees' accused devices are such slavish "Chinese copies" of the appellant's patented inventions that no justifiable limitation of any of the claims in issue of the patents in suit will avoid the deliberate infringement present in the appellees' accused devices in this case.

The clear error present in the judgment of the lower court in this case will be made apparent by an understanding of the inventions in suit and by a separate comparison of each of the claims in issue with the appellees' accused devices and with the prior art.

SPECIFICATION OF ERRORS.

The specification of errors relied upon is as follows:

That the United States District Court for the Southern District of California, Central Division, erred:

1. In failing to find that claims 1, 2 and 5 of patent in suit No. 2,199,611 are infringed, as is shown fully hereinafter.

2. In failing to find that claim 1 of patent in suit No. 2,233,395 is infringed, as is shown fully hereinafter.

3. In failing to order, adjudge and decree an injunction upon Letters Patent No. 2,199,611, particularly claims 1, 2 and 5 thereof, because they are being infringed.

4. In failing to order, adjudge and decree an injunction upon Letters Patent No. 2,233,395, particularly claim 1 thereof, because it is being infringed.

5. In failing to order, adjudge and decree that plaintiff is entitled to costs, and an accounting, because the patents in suit have been infringed and appellant has been damaged.

6. In making the following Findings of Fact set forth in detail at pages 306 to 310 of the Record on this appeal, and incorporated herein by reference, to-wit: II, III, IV, V, VI, X, XI, XII, XIII, XVII, XVIII, XIX and XX, because they are contrary to the evidence herein.

7. In making the following Conclusions of Law set forth in detail at page 310 of the Record on this appeal, and incorporated herein by reference, to-wit: 2, 3 and 4, because they are contrary to all of the evidence herein, and the law applying thereto.

ARGUMENT.

It is appellant's contention:

(1) That the inventions of the patents in suit constitute steps forward in their art, and that, as such, they are entitled to a liberal interpretation of the claims in issue herein.

(2) That the validity of the patents in suit has been finally held by the court below and is not open to attack in this appeal.

(3) That Claims 1, 2, and 5 of Patent in Suit No. 2,199,611 are infringed by the appellees' accused structures like appellant's Exhibit 12, shown in appellant's Exhibit 10.

(4) That Claim 1 of Patent in Suit No. 2,233,395 is infringed by the appellees' accused structures shown in appellant's Exhibits 8 and 9, and illustrated in appellant's Exhibit 11.

POINT (1)

The inventions of the patents in suit constitute steps forward in their art, and rapidly supplanted the prior art structures and therefore they are entitled to a liberal interpretation of the claims in issue herein.

The Invention in Suit.

The inventions of the patents in suit, one of which is a division of the other, concern valve operating structures and safety apparatus for boilers, such as those used in oil fields for generating the steam necessary to drill an oil well.

At the time that the inventions of the patents in suit were made many of these boilers were blowing up in the oil fields, causing great losses of life and property. Exhibits 6, 6a, 7, 7a and 7b show the remains of boilers which have gone through such explosions.

The invention and use of the inventions of the patent in suit virtually completely eliminated these explosions.

The invention of the patent in suit thus constituted a distinct step forward in the art.

In order to understand why the invention of the patent in suit constituted a distinct step forward in the art it is necessary to understand the causes of these boiler explosions before the invention of the patents in suit, the safety equipment in existence at that time, and the means by which the invention of the patents in suit accomplished this forward step of stopping those frightful and then-prevalent boiler explosions.

These boilers consisted of an outer shell, an inner shell of substantially similar but smaller configuration and suitable fuel fed burners. The burners directed their heat against the under surface of the inner shell, the top of which is called a "crown sheet." Between the two shells water was fed to a desired height. The effect of the heat from the burners directed on the crown sheet below the water is to heat the water and turn some of it into steam. This steam fills the space above the water between the inner and outer shells. This steam is then fed by suitable piping to the oil well drilling rig where it is used to drill the well. More water is fed to the boiler as the water is turned into steam and used.

Sometimes, through neglect or failure of some of the "feed water" mechanism, the level of the water fell until there was little or no water on top of the crown sheet. This often led to very serious boiler explosions, of two types.

The first type, a vertical explosion, was caused when all of the water on top of the crown sheet was turned into steam, leaving the crown sheet uncooled by surrounding water. In such cases the heat of the crown sheet often

became so excessive that it caused the crown sheet to buckle and fall in, resulting in the first type of explosion, usually in a vertical direction. Remains of such explosions are pictured in Exhibits 6 and 6-A.

The second type of boiler explosion, usually in a horizontal as well as a vertical direction, remains of which are pictured in Exhibits 7, 7-A and 7-B, is caused by the fireman adding water when the level of the water is so low and the heat of the crown sheet is so great that the water turns into steam faster than the safety valves can take care of it. This causes a sudden rush of steam in the boiler which then explodes in all directions, frequently causing loss of life or injury to personnel.

At the time that appellee invented the inventions of the patents in suit he was in constant touch with the oil fields and the equipment available therein because he was manufacturing and selling alarms which warned the operator when the water got dangerously low. These were called "low water alarms."

Appellee testified [R. p. 38], and the whole record herein shows, that when he invented the inventions of the patents in suit these low water alarms were the only safety apparatus in existence in the oil fields to guard against these explosions which were taking a fearful toll of lives and property.

The fatal defect in these "low water alarms" that simply sounded a warning when the water level fell to a certain point was that when the alarm sounded the boiler attendant was frequently busily engaged somewhere else and he would keep on with the job he was working on, intending to take care of the cause of the low water alarm's sounding "in a few moments." The trouble was he waited too long and the boiler blew up [R. p. 39].

Appellee saw that what was needed was a mechanism

that would make the boiler attendant drop whatever he was doing when the alarm sounded and go at once to rectify the situation.

The possibility of an explosion seemed too remote. The fact that these explosions occurred frequently proved that the danger of a possible explosion was not a sufficient incentive to make the attendant drop what he was doing and take care of the water supply in the boiler.

Though these explosions occurred "frequently" over the industry as a whole, they occurred "infrequently" on an individual lease, so there were plenty of boiler attendants who never saw a boiler explosion. This is why these boiler attendants regarded the danger of an explosion so lightly.

Appellee solved this problem by his invention of the patents in suit. The way that appellee solved this problem was to provide a mechanism which automatically shut off the supply of fuel to the boilers AFTER a lapse of time following the sounding of the whistle alarm. The amount of this lapse of time could be adjusted and predetermined because the fuel shut off mechanism was actuated after the water level in the boiler fell a predetermined distance below the point where the alarm whistle was sounded.

The effect of this on the boiler attendant was magical. He knew that if he didn't repair the feed water system promptly after the alarm whistle started blowing the fuel line would be shut off. This would cause the steam to go down and the drilling operations would be stopped. At once the driller, who was the boiler attendant's boss, would leave the rig and come back to the boilers to find out why the attendant had let the steam pressure go down.

Human nature is such that the boiler attendants were more afraid of incurring the wrath of their boss than

they were of a possible (to them highly remote) explosion. Hence, they jumped to fix the feed water system after the alarm started blowing when the invention of the patents in suit was installed on their rigs.

The testimony shows that these boiler explosions stopped when the invention of the patents in suit was made and one of them was installed on a rig.

It seems a simple matter—one that anyone could have thought of. But the fact is that no one thought of it until the appellant invented it. Such is the situation quite often in the case of inventions of the greatest merit. No one could solve the problem before the inventor, but AFTER he solved it by making the invention, everyone is ready to say how simple, how obvious it is—that is everyone except our courts which have steadily upheld the rights of inventors of valuable inventions that were so simple that everyone, especially the infringing defendants, said how obvious it was AFTER the invention was made.

This Court did it quite recently in a decision rendered on June 15, 1948, *Bianchi v. Barili*, 78 U. S. P. Q. 5, in which this Court quoted *Loom Co. v. Higgins*, 105 U. S. 580, 591-592, at page 9 of 78 U. S. P. Q. as follows:

“‘Now that it has succeeded, it may seem very plain to any one that he could have done it as well. This is often the case with inventions of the greatest merit.’” (Emphasis ours.)

Other law that was disregarded by the Lower Court is as follows:

The Law That Was Disregarded by the Lower Court.

In *Los Angeles Art Organ Co. v. Aeolian Co.*, 143 Fed. 880 (C. C. A. 9), this Court said at page 883:

“Their invention was therefore more than a mere improvement of what had preceded it.

It was of such novelty and importance as to constitute a DISTINCT STEP in the progress of the art, and the claims of their patent are therefore entitled to a broad and LIBERAL CONSTRUCTION. Morley S. M. Co. v. Lancaster, 129 U. S. 263, 273, 9 Sup. Ct. 299, 32 L. Ed. 715 and authorities there cited; Letson v. Alaska Packers Ass'n, 130 Fed. 129, 140, 64 C. C. A. 463; Brown Bag Filling M. Co. v. Drohan (C. C.), 140 Fed. 97." (Italics and capitals ours.)

This Court expressed similar views in *Von Schmidt v. Bowers*, 80 Fed. 121 (C. C. A. 9), at page 147 and in *Bianchi v. Barili*, 78 U. S. P. Q. 5 at page 6.

The rule thus enunciated by this Court may be summarized this way:

The claims of a patent for a meritorious invention which substantially advances the art should be given a liberal construction so as not to permit a defendant to escape who reaches the same result by analogous means even though there are superficial dissimilarities in the construction of the plaintiff's and defendant's devices.

If this Court will apply this test to the claims in issue and the appellee's accused devices in this case there can be only one decision.

It was the Lower Court's refusal to apply this Court's above well known rule of law to the facts in this case that caused it to fall into error and made necessary this appeal.

Perhaps the reason that the Lower Court fell into this error is found in the part of its "Memorandum Decision" that is printed on page 12 of the Record on this appeal.

There the Lower Court made the unique error of assuming that because the specification of a patent in suit herein used the word "improvements" it meant that the patent was a secondary patent and could not be a primary patent, or even constitute a substantial advance in the art.

This ruling of the Lower Court is a pure mistake of law and misunderstanding of patent practice. Practically all patents use the word "improvements" and its presence or absence is never intended by the patentee, his patent attorney or the Patent Office to indicate whether the patent is secondary or primary.

The prior art patents cited by the appellees in this case, for instance, no matter how old they are, use this word "improvement," as this Court can see by examining them.

Hence it was error for the Lower Court to base its conclusion of non-infringement upon the presence of the word "improvements" in the specifications of the patents in suit.

Obviously if the presence or absence of the word "improvement" in the introductory part of the specifications was the determining factor in testing whether the patent was secondary or primary, as the Lower Court holds at page 12 of the Record in this case, *no one would ever use the word "improvements"* lest it limit the scope of their claims.

Rather the word "improvements" infers the presence of "invention" in the device.

If this Court will read pages 12 and 13 of the Record in this case with this point in mind, it will see how the Lower Court fell into this error.

Finally it must be borne in mind that this invention of the patent in suit *rapidly supplanted the prior structures*, namely the whistle alarms alone [R. pp. 38-41, incl.; 289], and this fact also entitles it to a *liberal construction*.

Wensel v. Goldhill Hardware Mfg. Co., 21 F. 2d 974 at p. 976.

Section Summary.

Appellant has shown that he is entitled to a *liberal construction* of the patents in suit, first because the patented inventions constitute a substantial step in the art, and second because they rapidly displaced the prior devices.

Appellant will now briefly describe the patents in suit which cover the means by which he accomplished his distinct step which is *not found* in the prior art.

The Means by Which the Inventions in Suit Accomplished Their Substantial Advance in the Art, Namely, Stopping Those Boiler Explosions.

The means by which appellee achieved the substantial advance in the art described above are very simple.

PATENT NO. 2,199,611.

The first patent in suit, No. 2,199,611, describes and claims a valve mechanism which can be used as one of the elements of the combination described and claimed in the second patent in suit (No. 2,233,395) by which appellant accomplished the distinct forward step of consecutive actuation of a fuel shut off valve after a lapse of time after an alarm valve has been actuated.

PATENT NO. 2,233,395.

The second patent in suit, No. 2,233,395, describes and claims the combination of mechanism by which appellant accomplished the distinct forward step of automatically shutting off the fuel supply valve after the water level in the boiler had fallen a predetermined amount below the point where the alarm whistle was sounded, and hence after a lapse of time.

These mechanisms, as shown in the drawings, described in the specifications and claimed in the claims in issue of the patents in suit herein are fully described in detail hereinafter at the point where infringement is shown.

POINT (2).

Validity Not in Issue.

The validity of the patents in suit has been finally held by the Court below and it is not open to attack in this appeal.

It is not open to defendants-appellees to attack or question the judgment of the Court below finding the patents in suit valid because defendants-appellees did not file a cross-appeal.

An appellee not having appealed from a decree awarding him affirmative relief *cannot review* the denial of a portion of the relief which he sought. *Tjosevig et al. v. Donohoe et al.* (C. C. A. 9) 262 Fed. 911, 918; *Gay et al. v. Focke* (C. C. A. 9) 291 F. 721, 727; *Sanborn Cutting Co. v. Paine* (C. C. A. 9) 244 F. 672, 681.

He may not, in the absence of a cross-appeal, attack the decree with a view either to enlarging his own rights thereunder or of lessening the rights of his adversary, whether what he seeks is to correct an error or to supplement the decree with respect to a matter not dealt with below. The rule is inveterate and certain. (*Construction Co. v. Maryland Casualty Co.*, 300 U. S. 185, 57 S. Ct. 325, 81 L. Ed. 593. See also *Stepp v. McAdams etc.* (C. C. A. 9) 83 F. (2d) 925; *The Maria Martin*, 79 U. S. 31, 40, 20 L. Ed. 251, 252; *Union Tool Co. v. Wilson*, 259 U. S. 107, 111, 66 L. Ed. 848, 851, 42 S. Ct. 427).

An appellee may not attack a judgment even on grounds asserted in the Court below, in an effort to have the Court reverse it, when he himself has not sought review of the whole judgment, or of that portion which is adverse to him.—O'Brien's "Manual of Federal Appellate Procedure," Third Edition, pages 54-55.

Therefore, the validity of the patents in suit may not be questioned or even argued on any ground whatsoever by appellees in this Court on this appeal.

Furthermore the presumption of validity created by the issuance of the patents in suit is greatly strengthened and increased by the fact that the District Court sustained the validity of the patents in suit herein. In *Bianchi v. Barili*, 78 U. S. P. Q. 5, this Court said at page 6:

“Particularly heavy is the attacker’s burden when the validity of the patent has been sustained by court findings.” (Citing cases.)

Preliminary Summary.

Since the claims in issue of the patents in suit have been thus held valid, appellant will conclude this Opening Brief by considering the claims in issue herein, showing their clear embodiment in the appellees’ accused devices, the remoteness of the prior art cited by appellees in the court below, and the impossibility of that art limiting any of the claims in issue herein.

They will show that the valid claims in issue herein are

- (1) Obviously infringed, and
- (2) Not limited by the prior art.

In analyzing the following pages of this brief this Honorable Court is earnestly urged to keep in mind the *liberal construction* to which the patents in suit are entitled under the authorities cited in the first section of this brief because of *the substantial advance* made in the art by the invention of the patents in suit herein.

POINT (3).

Claims 1, 2 and 5 of patent in suit No. 2,199,611 are infringed by the appellees' accused structures like Exhibit 12, shown in Exhibit 10.

Claim 1.

The following elements of Claim 1 of patent in suit No. 2,199,611 are clearly shown in the drawings and described in the specifications, they were shown at the trial to be equally clearly present in appellees' accused structure [R. pp. 62-66] and appellees will not deny, and therefore they will admit that they are embodied in their accused devices:

- (a) "*A housing*" [see patent in suit No. 2,199,611, spec. p. 1, col. 1, lines 46-48 and R. p. 62 to 64].
- (b) "*A plurality of outlet passages through said housing*" [see spec. p. 1, col. 1, lines 52, to col. 2, line 3, and R. p. 64].
- (c) "*A valve in each of said passages*" [see spec. p. 1, col. 2, lines 7 to 11, and R. p. 64].
- (f) "*Operated by a lever fulcrumed within said housing*" [see spec. p. 1, col. 2, lines 30 to 35, and R. p. 65].
- (g) "*A float on the end of said lever*" [see spec. p. 2, col. 1, lines 4 to 6, and R. p. 65].
- (h) "*Whereby said valves are opened one at a time in sequence, responsive to the downward movement of said float*" [see spec. p. 2, col. 1, lines 7 to 17, and R. pp. 65 to 66].

The only elements of claim 1 of patent No. 2,199,611 that appellees will contest are elements (d) and (e). Appellant will therefore now show that these elements are also clearly embodied in appellees' accused structures.

In considering these elements (d) and (e) this Court should remember that the file wrapper of this patent in suit No. 2,199,611, Exhibit "K" herein, shows that appellant was not forced to insert these limitations (d) and (e) by the prior art or by the Patent Office, and, for this reason also, a *liberal construction* should be accorded these elements and these claims.

(d) "SAID VALVES HAVING SLOTS OF VARYING LENGTHS IN ONE END TO DETERMINE THE ORDER IN WHICH THEY ARE OPENED."

This element of Claim 1 of this patent in suit is described in the specification of this patent in suit at page 1, column 2, lines 11 to 29.

Turning to the appellees' structure shown on the right hand side of Exhibit 10, it is seen that the accused structure embodies this element of claim 1 in letter and in spirit. Applying the aforesaid description from page 2, column 2, lines 11 to 29 of the specification of this patent in suit in quotes herebelow, to the appellees' accused structure, it is seen that:

"Each valve, 15 and 16, has a rearwardly extending valve stem." The rearwardly extending valve stem of valve 15 is marked 17 in Figure 2 and the rearwardly extending valve stem of valve 16 is made in two pieces, suitably joined together, instead of in one piece. (This will be discussed more fully hereinafter.) There is "an opening in each rearwardly extending valve stem to receive a crosspin" marked 25 in Figure 2 (instead of 18, the number used in this patent in suit). This crosspin is likewise made in two pieces instead of one (which will be discussed more fully hereinafter) and the crosspin 25 is "mounted on the valve operating lever 20."

"In order that the valves 15 and 16 may be operated in a predetermined sequence the openings through which

the crosspin 25 passes are of different lengths in the different valve stems." The appellees have made "the stem of the valve 15 as providing a close fit about the pin 25. In the stem of the valve 16, however, the opening is elongated, as shown at 21 [in Figure 1 of Exhibit 10]. It will be noted that there are only two valves in the appellees' accused structure instead of three.

"It will be obvious from this construction that when the lever 20 is operated to move the valves, the valve 15 will be moved first and at a predetermined interval thereafter the valve 16 will be opened." It is noted that the valve 15 opens the passageway to the steam pipe 11 which communicates with the whistle and the valve 16, which is opened a predetermined period afterward, communicates with the steam pipe 12 which in turn leads to the fuel shut-off valve and closes it when the steam passes through that passageway 12.

It is obvious that the appellees' structure has all of the above characteristic features of this element of claim 1 that are described in the specification of this patent in suit.

The only differences between the appellees' structure and the structure shown in the drawings in the patent in suit are that two of the parts, namely the valve stem of valve 16 and the pin 25, are each made in two parts instead of one.

Functionally the appellees' and appellant's structures operate exactly the same. The reason that appellees made these parts in two pieces instead of one was to attempt to evade infringement of this patent in suit, or to put it colloquially, to try to get around the patent.

It is because of this evasion by the appellees that appellant has quoted and cited the law hereinabove on the liberal construction to be accorded the claims of the patents

in suit because the inventions of the patents in suit represent substantial advances in the art.

At this point it is well for the Court to keep in mind and consider the authorities cited hereinabove to that effect.

Not only are those authorities controlling to find infringement at this point, but also there are specific authorities that a defendant cannot evade the consequences of his infringing act by making a part in two or more pieces if that part performs the same work in substantially the same way as a single part did in the structure shown in the patent in suit.

Some of the leading authorities which hold that a defendant who makes an element in two or more parts instead of one will not evade or avoid infringement by so doing are these:

Multiplication of Parts.

Infringement is not averted by the separation of one integral part into two, the two parts doing substantially what was done by the single part.

This principle is thoroughly established. It was well stated by this Court in:

King County Raisin & Fruit Co., et al. v. United States Consol. Seeded Raisin Co., 182 Fed. 59 (C. C. A. 9), at page 63:

"Infringement is not avoided by the fact that one of the integral elements of his built-up impaling roll is by the appellants separated into two or more distinct parts, so long as the function and operation remain substantially the same. Kalamazoo Ry. Supply Co. v. Duff Mfg. Co., 113 Fed. 264, 51 C. C. A. 221; Bundy Mfg. Co. v. Detroit Time-Register Co., 94 Fed. 524, 36 C. C. A. 375; H. F. Brammer Mfg. Co. v. Witte Hardware Co., 159 Fed. 726, 86 C. C. A. 202." (Emphasis ours.)

See also:

Walker on Patents, Deller's Edition, Section 462
at pages 1698-1699;

Nathan v. Howard, 143 Fed. 889 (C. C. A. 6), at
page 893;

Western Tube Co. v. Rainear, 156 Fed. 49 at page
56;

Line Material Co. v. Brady Electric Mfg. Co., 7
F. 2d 48 (C. C. A. 2), at pages 50 to 51;

Arthur Colton Co. v. McKesson & Robbins, Inc.,
58 F. 2d 157 at page 158;

Skelton et al. v. Baldwin Tool Works, 58 F. 2d
(C. C. A. 4), 221 at page 227.

That the appellees' structure operates in substantially the same way to produce substantially the same result and therefore it infringes this element of claim 1 was clearly and unequivocally shown at the trial and by the exhibits. The slot 21 of Figures 1 and 2 in Exhibit 10 works just the same as the slot 22 in Figure 2 of the patent in suit. This result is to accomplish a delayed action and to move the valve 16 off of its seat after the level of the water has receded a certain amount. Of course, adjustment of the amount of this recession before the fuel shut-off valve is operated is effected by varying the length of the slot. Certainly the length of the slot 21 in the appellees' structure in the right hand side of Exhibit 10 varies from the sliding fit slot in valve 15 in Exhibit 10 in the same identical manner that slot 22 of valve 14 in Figure 2 of the patent in suit varies from the loose sliding fit of the slot in valve 16 of the patent in suit. The purpose of this variation in length of slot is to allow a period of recession of the water between the place that the first control valve [15 in Figure 2, Exhibit 10, appellees' structure and 16 in Figure 2 of the patent in suit], is pulled off its seat and the place where the fuel control valve operating unit valve

[16 in Figure 2 of the appellees' structure in Exhibit 10 and 14 in Figure 2 of the patent in suit], is pulled off its seat, thus actuating the mechanism that closes the fuel shut-off valve.

Appellee Pinkerton, clearly and unequivocally admitted infringement of this element at pages 283-285 of the Record on this appeal as follows:

“Q. If the second valve is hooked up to the fuel shut-off in your device, the lowering of the arm past the point where the first valve is opened to the point where second valve is opened will not perform any additional function or work than *closing* the fuel shut-off valve, will it? . . . A. Yes, it will close it. . . .

Q. It will close it? A. Yes.

Q. *It doesn't do anything else besides close it?*

A. *That is all.*

Q. So that the work that the second valve in your structure, Exhibit 12, does, and the work that the second valve in the Blanchard structure, Exhibit 5, does, is exactly the same, isn't it? A. I would say the job was the same, yes. . . .

Q. By Mr. Jamieson: *The result is exactly the same?* A. *Yes.*

Q. *And the way that that result is accomplished is the same in both valves, isn't it?* A. *Yes.*” [R. pp. 283 to 284.] (Emphasis ours.)

“Q. *Between the valve seat and the pin in Blanchard's, there is just one piece or member, isn't there?*

A. There is just one valve.

Q. One piece of mechanism? A. *Yes.*

Q. *And between the valve seat and the pin in your device there are two pieces of mechanism, aren't there, whatever you call them, there are two pieces of mechanism, aren't there?* A. *Yes.*

Q. *The one piece of mechanism in Blanchard's and the two pieces of mechanism in yours perform the same identical work, don't they? . . . A. Yes, they open the valve.*" [R. pp. 284 to 285.] (Emphasis ours.)

Obviously this element of claim 1 of this patent in suit is clearly embodied in the appellees' accused structure. Appellees should not be permitted to escape the consequences of their clear infringement by the fictitious argument that they have made two of the parts, namely, the extension of valve 16 and the pin 25 in two parts instead of one, calling the second part a "lever," particularly when the appellee Pinkerton himself admits in the above excerpts that they do "the same identical work," that "the result is exactly the same," and that "the way that that result is accomplished is the same in both valves;" and when the Court can see by manipulating the valves themselves that they do that "same identical work" in substantially the same manner.

When the Lower Court erroneously decided this issue in favor of the appellees and precipitated this appeal, it committed a gross abuse of discretion and violated the law, both the law of the *liberal construction* to be accorded the patent in suit, as quoted earlier in this brief, and the law that it does not evade infringement to make a part in two parts instead of one.

To right this wrong appellant brought this appeal and appellant feels certain that this Court will not permit these appellees to purloin this valuable invention by the illegal subterfuge of making some of the parts in two pieces instead of one, and calling the second part by another name.

(e) "A PIN THROUGH SAID SLOTS."

This pin is described in the part of the specification quoted in the preceding element of this claim and is numbered 18 in the patent in suit.

The essence or mental concept of this element of claim 1 is a member which is rigidly attached to the lever 20 so that it can function integrally as a part of the lever 20 (the next element of this claim specifies that this element is "*Operated by a lever*" 20) to contact the rear end of an opening in another member connected to the valves in order to pull the valves off of their seats.

Applying this concept to the appellees' accused structure, Exhibit 10, it is seen that the pin 25 is made in two pieces and that it is attached to, or mounted on the lever 20. One piece is mounted on the end of the lever 20 at 25 in a yoke like the yoke 19 shown in Figure 2 of this patent in suit. The other piece of this pin 25 is mounted close to the first piece at another point on the lever 20.

The function of these two pieces is to contact the inner ends of the valve slots consecutively and pull the appellees' valves off their seats in sequence.

The piece of pin 25 mounted in the yoke will contact the inner end of the slot on the extending valve stem 17 of valve 15 and will pull valve 15 off of its seat 13 when the float 33 and the arm 20 fall beyond the point where it is desired to start the alarm whistle blowing continuously.

At a predetermined interval thereafter, depending upon the length of the slot 21 in appellees' accused structure, the other piece of pin 25 will contact the inner end of slot 21, which is connected to valve 16 as an extension of valve 16's valve stem which is made in two pieces instead of one. This contact of pin 25 with the inner end of slot 21 will cause appellees' valve 16, which may be connected to

a fuel shut-off valve, to be pulled off of its seat 13 when the float 33 and its connected arm 20 falls beyond the point where pin 25 has contacted the inner end of slot 21. This mode of operation is substantially the same as the mode of operation of the analogous mechanism in the drawings of this patent in suit.

This is another and final illustration of the appellees' attempts to evade their clear infringement of this patent by making parts or elements in two pieces instead of one. The authorities on the *liberal construction* to be accorded because of the *substantial advance* in the art, cited hereinabove, and also the specific authorities that a defendant will not be permitted to evade his infringement by making a part or element in two pieces instead of one, will control this element of this claim of this patent in suit in the same manner that these authorities control the preceding element of this claim which was covered fully hereinabove.

On cross-examination the appellee Pinkerton also admitted that the two-piece pin in his accused device gets the same result as the one-piece pin in Blanchard. [R. p. 286.]

Appellee Pinkerton also admitted that the two-piece pin and the two-piece valve stem in his structure did the same work and the same job in the same way as the one-piece pin and valve stem in Blanchard as follows:

“Q. So that *the work of the second valve in your structure, Exhibit 12, does, and the work that the second valve in the Blanchard structure, Exhibit 5, does, is exactly the same, isn't it?* A. *I would say the job was the same, yes.*

Q. And the job is to shut that fuel shut-off valve?

A. If you are hooked to a fuel valve, yes. . . .

Q. *The result is exactly the same?* A. *Yes.*

Q. *And the way that that result is accomplished is the same in both valves, isn't it? A. Yes.*" [R. pp. 283 to 284.] (Emphasis ours.)

Therefore, the two pieces of the appellees' pin and the two pieces of the appellees' valve stem operate in "substantially the same way" and accomplish "substantially the same result" as the one-piece pin and one-piece valve stem in the patent in suit, and, under the law cited fully hereinabove, this is infringement.

Also this Court under similar circumstances recently held that such a change would not avert infringement.

Bianchi v. Barili, 78 U. S. P. A. 5, at page 10:

"The mere transfer of the axial cutters from the roller containing the molds to the other roller, containing the annular peripheral cutters, does not avert infringement. The means and the function of cutting in the two machines are identical. Exactly opposite to this sort of transposition is the language found in 3 Walker, Sec. 463, page 1699:

"'Changing the relative positions or reversal of the parts of a machine or manufacture does not avert infringement, where the parts transposed perform the same respective functions after the change as before.'

"Bianchi himself testified that the position of the cutters was immaterial." (Emphasis ours.)

For all of the above reasons appellant submits that this element of Claim 1 of this patent in suit is embodied in appellee's accused structure and that it operates in substantially the same manner and accomplishes substantially the same result. Therefore, infringement of this element of Claim 1 of this patent in suit No. 2,199,611 has been fully shown.

This Court stated the true rule in finding infringement in *Bianchi v. Barili*, *supra*, at page 11 of 78 U. S. P. Q.:

“A leading text-writer on the law of patents has pointed out that infringement is a question of fact. 3 Walker Sec. 450, page 1680.

“It is also a question of substance, and not of nomenclature. *It is not to be settled by striving to ascertain the difference between tweedledum and tweedledee.*

“In *Hydraulic Press Mfg. Co. v. Williams, White & Co.* (C. C. A. 7), 165 F. 2d 489, 492 (76 U. S. P. Q. 559, 562), the court said:

“*In determining the question of infringement, the court is not to judge about similarities or differences by the names of things, but is to look at the machines or their several devices or elements in the light of what they do, or what office or function they perform, and how they perform it.* (Case cited * * * One does not escape infringement by providing a single element which fully responds to a plurality of elements in the patent. (Case cited.)’

“So here, Bianchi did not escape infringement by putting all his cutters on one roller, for he thereby was ‘providing a single element which fully responds to a plurality of elements (*i. e.* two cutting rollers) in the patent.’

“Nor need the substantial identity between the two machines be demonstrated to a mathematical certainty. In *City of Grafton, W. V. v. Otis Elevator Co.* (C. C. A. 4), 166 F. 2d, 816, 821 (76 USPQ 450, 453), the following language was used:

“‘Rarely do we find an example of what might be called perfect infringement. *No patent infringer would be so silly as to make and vend a device similar in every minute detail to a patent.* Infringement

connotes between the patent and the accused device, merely correspondence as to the substantial, dominant and essential elements. *Any other view would make of a patent a foolish and fatuous thing.*'” (Emphasis ours.)

It is perhaps inconceivable that any court would decide directly contrary to that vast weight of authority that making a device in two parts instead of one will evade infringement, but that is exactly what the Court below did in its appealed “Memorandum Decision” in this case, as follows:

“It is evident that the claims call for a *single* pin
. . .

“The accused devices do *not* have a *single* pin
. . .

“Pinkerton . . . uses *two separate* pins . . .

“So, admitting that the result is the same, the means by which it is achieved are so dissimilar from those of the patent in suit as to prevent . . . a finding of infringement.” [R. p. 17.]

This obviously erroneous legal conclusion is repeated in the “Findings of Fact” (No. 18) appealed from herein, as follows:

“The separate pins of the accused structures are not the equivalent of the cross-pin shown or claimed in the 2,199,611 patent” [R. p. 24].

This Honorable Court can right this wrong that has been done to appellant by following the well established rule that it does not avoid infringement to make a part in two or more pieces that do the same work in substantially the same way and reverse the erroneous ruling below with appropriate instructions to the Lower Court.

Summary.

It has been fully shown that the appellees' accused structure includes each of the elements of claim 1 of patent in suit No. 2,199,611.

Infringement of Claims 2 and 5.

The foregoing detailed analysis showing the clear infringement of claim 1 and explaining the meaning of the words and phrases in the claim will enable the Court to easily apply claims 2 and 5 of this patent in suit No. 2,199,611 to the appellees' accused structure, keeping in mind that each claim is separate and stands on its own feet, and that infringement of claims 2 and 5 was fully shown at the trial [R. pp. 67-72]. Appellant feels that due to the limitation of the length of this brief it will be more helpful to the Court to use the space that would be necessary to treat claims 2 and 5 of this patent as claim 1 was treated, by explaining and disposing of the prior art cited by the appellees.

It will be obvious when claims 2 and 5 of this patent in suit No. 2,199,611 are compared with the appellees' accused structure, shown in Exhibit 10, in the same manner that claim 1 was compared hereinabove [see R. pp. 67-72] that claims 2 and 5 of this patent in suit No. 2,199,611 are clearly and irrefutably embodied in appellees' accused structure and that therefore the appellees' accused structure is an infringement of claims 2 and 5 as well as of claim 1 of this patent in suit No. 2,199,611.

Appellant will now show that the prior art cited by appellees does not in any way limit the scope of the claims of this patent in suit No. 2,199,611 and that this prior art may be completely disregarded in considering the infringement of this patent in suit by appellees' accused structure.

The Art Prior to Patent No. 2,199,611.

In this case the appellees took the whole gist of the invention by copying it exactly except that two small parts were each made in two pieces instead of one, but the function performed by the two parts was identical with the function performed by the single parts in the embodiment shown in the drawings of the patent in suit and *any range of equivalents at all will cover these obvious evasions.*

No prior art device has the appellant's structure but with these parts made in two pieces—so this evasion is not founded on the prior art.

Also no new or added function is performed by appellees' two-piece constructions.

Appellee Pinkerton admitted all this flatly at the trial [R. pp. 282-285] as follows:

“Q. By Mr. Jamieson: *Does your valve do anything in addition to what Blanchard's does, the first one?* A. *No.*” [R. p. 282.] (Emphasis ours.)

“Q. If the second valve is hooked up to the fuel shut off in your device, the lowering of the arm past the point where the first valve is opened to the point where the second valve is opened will not perform any additional function or work than . . . *closing . . . the fuel shut off valve will it?* A. Yes, it will close it . . .

Q. *It doesn't do anything else besides close it?*
A. *That is all.*

Q. So that the work that the second valve in your structure, Exhibit 12, does, and the work that the second valve in the Blanchard structure, Exhibit 5,

does, is exactly the same isn't it? A. *I would say the job was the same, yes . . .*

Q. By Mr. Jamieson: *The result is exactly the same?* A. *Yes.*

Q. *And the way that that result is accomplished is the same in both valves, isn't it?* A. *Yes.*" [R. pp. 283-284.] (Emphasis ours.)

"Q. *The one piece of mechanism in Blanchard's and the two pieces of mechanism in yours perform the same identical work, don't they?* A. *Yes, they open the valve.*" [R. p. 285.] (Emphasis ours.)

With these principles in mind appellant will now review and dispose of the prior art cited by appellees in this case against this patent in suit, No. 2,199,611.

The Prior Art.

Validity of the patents in suit has been fully established.

First: The Patent Office found them valid and issued them.

Second: The Lower Court held them valid in this case, and

Third: The appellees did not appeal from the Lower Court's finding of validity.

Infringement of the *prima facie* reading of the claims in issue of this patent in suit has been clearly shown in the immediately preceding section of this brief.

It remains only to consider the appellees' prior art and show that it does not disturb this clear *prima facie* infringement.

Appellant has pointed out the authorities holding that if a *substantial advance* has been made in the art the patentee is entitled to a *liberal construction of his claims*.

A liberal construction is at least a prima facie construction and appellant has shown that a prima facie construction will find the appellees' accused structures to be infringements.

Therefore it is only necessary now to prove by a consideration of the prior art that the invention of this valid patent in suit is a sufficiently *substantial advance* in the art over appellees' prior art references to not disturb this clear *prima facie* infringement which was fully demonstrated hereinabove.

Appellant will show that the invention of this patent in suit is a *substantial advance* in the art by comparing it with the structures selected by the appellees below as their "best references." Then it will follow that, since the invention of this patent in suit is a *substantial advance* over appellees' "best references," it also is a *substantial advance* over appellees' remaining prior art, presumably their worst references.

I.

Appellees' "Best References."

At pages 212-212a of the transcript appellees in response to a query from the Lower Court, named Baldwin and Wright as their "best references" for this patent in suit.

Appellant will now consider those "best references" in that order and show that the invention of this patent in suit is a *substantial advance* over each of them.

(1) Baldwin, No. 716,982 Issued December 30, 1902.

This Baldwin device is neither designed nor intended to perform the function or do the work of this patent in suit and it cannot achieve the results that are accomplished by the patented combinations of claims 1, 2 and 5 of this patent in suit No. 2,199,611.

It is not necessary to repeat here the description of the complicated parts of this Baldwin patent which are fully explained in the patent itself. It suffices to point out the differences between Baldwin and this patent in suit and to show the substantial advance in the art achieved by this patent in suit over Baldwin.

Claims 1 and 2 of this patent in suit are limited to combinations and modes of operation upon "the downward movement" of the float or lever. Therefore this feature will be considered first.

In Baldwin *downward* movement of the float c will open only *one* valve, namely, needle valve c-22, which actuates a whistle G [R. p. 299].

Thus Baldwin is exactly like the old prior art whistle alarms that were common when appellant invented the patents in suit [R. p. 38].

If the water falls too low it blows a whistle, G, just like all the other whistle alarms.

There is no part or mechanism in Baldwin that is actuated or can be actuated after the whistle blows and the water falls still farther.

Also no other valve than C-22 can be actuated by the downward movement of float C in Baldwin.

Baldwin has two passages, C-23 and C-24, leading to passage g, which leads to whistle G, but these passages are only used at the extreme movements of the float c in *opposite directions*, as is shown by page 2, column 2, lines 126 to 133, inclusive, of the Baldwin specifications.

On the other hand the steam relief valve, C-3, is always operated at positions *within* these two extremes and *cannot* be actuated *outside* these extremes, or *after* the whistle valve is sounded.

Therefore this Baldwin device not only does not suggest or show the invention of the patents in suit, but Baldwin could not be used to do the work or perform the function of the patents in suit.

In short Baldwin is a mere whistle alarm valve like the prior art actual valves, such as the Reliance valve, appellees' Exhibit A, which were such failures that they caused the appellant to invent the inventions of the patents in suit to meet the need caused by the failures of these prior art whistle valves [R. pp. 38-42].

The appellant made this very clear at the trial of this case [R. pp. 38-39], as follows:

“Q. By Mr. Jamieson: How did you come to invent the patents in suit? Will you tell us the story?

A. I manufactured alarms for a number of years, and the alarms were pretty good, but I noticed a few customers began to take the alarms off because they said the firemen wouldn't pay any attention to the whistle and would continue whatever they were doing, and the water in the boiler would get low anyway,

even with the whistle blowing. So I contacted the manufacturers of alarms other than myself at that time, and tried to find some concern that would make an automatic fuel shut-off valve that would operate in connection with the alarm. Well, there was none at that time on the market, and . . .

Q. Did you make any other investigations? A. Well, in the fields, of course. There was nothing of that kind in use and nothing on the market, so I began experimenting for a means to accomplish this, and I finally accomplished it in '33. Then I think I sold my first complete unit in 1934, and during the next year I applied for a patent on the entire device.

Q. What were some of the troubles that you encountered that caused you to make the invention of the patents in suit? A. Well, a great many customers were even taking the alarms off alone.

Q. Why? A. Because the firemen would hear the whistle blow and they would think they had so much time before they would actually have a dangerous condition, and they would continue doing whatever they were doing, and often times they were busier longer than they thought they would be, and the water would continue until it got to the dangerous point.

Q. What happened when it got to the dangerous point? A. Well, when it got to the dangerous point they either had to shut the boiler down completely, or the fireman would take a chance on putting the water in the boiler, and I know in at least one instance the fireman took that chance of putting the water in the boiler and blew it up." [R. pp. 38-39.]

This Baldwin device is exactly the same as those prior alarms whose deficiencies the invention of the patent in suit was invented to overcome.

Baldwin has a high water alarm valve C-19, and a low water alarm valve, C-22, but it has no consecutively actuated secondary valve that could be used to shut off the fuel line after the water in the boiler had receded below the point where the whistle starts blowing for the low water alarm (C-22).

In Baldwin the steam valve C-3 operates on the *upward movement* of float C, and, which is fatal to Baldwin as a limitation in this case, this steam valve C is actuated *between* (and hence *before*) valves C-19 and C-22 that sound alarm G.

Also steam valve C-3 can *never* be actuated *after* the whistle alarm G has been sounded.

In this patent in suit to Blanchard a master control unit is provided whereby a fuel shut off valve can be closed *after* a whistle alarm has been sounded and the level of the water has fallen. This is not possible in Baldwin.

In other words *Baldwin has no master control unit like that shown in Figure 2 of this patent in suit No. 2,199,611, to consecutively open two steam valves on the downward movement of the float 33.* (See Figures 1 and 2 of patent No. 2,199,611.)

This master control unit is an essential characteristic feature of the patents in suit. It is an element of the combination of the second patent in suit No. 2,233,395, and it is the subject of the first patent in suit No. 2,199,611.

In other words the first patent in suit No. 2,199,611 covers the details of one kind of master control unit, and the second patent in suit includes any kind of a master control unit as an element of its claimed combinations.

Baldwin's lack of a master control unit completely disqualifies it as a reference and prevents it from limiting the scope of the claims of the patents in suit.

The presence of this vital master control unit in this patent in suit demonstrates and proves that this patent in suit, No. 2,199,611, is a *substantial advance* over this patent to Baldwin No. 716,982, which has no master control unit.

In the Lower Court the appellees offered drawings and arguments attempting to change and modify Baldwin to make it look like this patent in suit.

But the law is very clear that the appellees may not change the inadequate prior art cited by them or make theoretical modifications in it to try to produce the patent in suit.

In *Wensel v. Goldhill Hardware Mfg. Co.*, 21 F. 2d 974 at page 976, Judge McCormick said:

“I think that by relying on Vachette modified, defendant confesses that the French patent does not anticipate Wensel’s concept as shown by the patent in suit. *The modified Vachette is not a part of the prior art.* (Citing cases.)

“The suggested modification has been made by *the light of Wensel’s teachings. It is a subsequent art, created in the endeavor to defeat Wensel’s concept.*” (Emphasis ours.)

See also:

Ludwigs v. Payson Mfg. Co., 206 Fed. 60 at page 64 (7th C. C. A.);

Diamond Power Specialty Corp. v. Bayer Co., 13 F. 2d 337 at 341 (8th C. C. A.).

Also mere comparison of the flimsy, impractical Baldwin device and the *proven success* of this patent in suit [R. pp. 41-42 and 86], shows that the patent in suit is a *substantial advance* over Baldwin, which issued in 1902 and never was anything more than a mere paper patent—a file in the Patent Office.

Clearly Blanchard is a great *step forward* over Baldwin.

(2) Wright, No. 668,302 Issued February 19, 1901.

Validity of this patent in suit, No. 2,199,611, over Wright has been finally held and demonstration of *prima facie* infringement of claims 1, 2 and 5 of this patent in suit by appellees' accused structure has been pointed out hereinabove.

It remains only to show that this patent in suit, No. 2,199,611 is a sufficiently *substantial advance* over this second, and last, "best reference," Wright, selected by appellees at the trial [R. pp. 212-212a]. This was shown by appellant at the trial [R. pp. 300-302].

One of the features of this patent in suit, No. 2,199,611, that is present in each of the claims in issue, Nos. 1, 2 and 5 is "a plurality of outlet passages" through the housing or plug. The specification of this patent in suit, No. 2,199,611 describes those passages at page 1, column 1, line 52, to column 2, line 6.

Each of these claims 1, 2 and 5 of this patent No. 2,199,611 specifically specifies that this "plurality", *i. e.*, "two or more," of outlet passages be "*through*" the housing or plug. The obvious reason for this limitation of the outlet passages being "*through*" the wall of the housing or plug is to *separately* "conduct the steam to any steam operated device" [Spec. p. 1, column 2, lines 5-6].

Separate outlets to separate steam operated devices that may be "opened one at a time in sequence," as claims 1 and 2 specify, are elements of the claims and essential ingredients of the patented combinations of the valid claims in issue of this patent in suit.

But these separate outlets are not present in Wright, No. 668,302, appellees' second "best reference."

Instead Wright has just one outlet, a-8 in Figure 1, and therefore Wright does not have a "plurality" of outlet passages.

Wright does not and cannot operate a plurality of “steam operated devices,” let alone operating them “one at a time in sequence,” as the claims in issue of this patent in suit specify.

Therefore Wright is not only not designed nor intended to do the work or perform the function of this patent in suit—but it cannot be used to achieve the result that is accomplished by the patented claims of this patent.

This ability to operate a plurality of steam operated devices one at a time in sequence in response to downward movement of the float is an inherent characteristic feature of the invention covered by the valid claims of this patent in suit. It is clearly not present in Wright. Therefore the invention of this patent in suit represents a *substantial advance* in the art over this patent to Wright, which issued in 1901, and is a mere paper patent that never helped solve the problem that was so successfully met by the invention of this patent in suit [R. pp. 41-42].

There is no way that any of the claims in issue of this patent in suit No. 2,199,611 can be stretched or “interpreted” to make any of them cover this Wright device. No amount, range or degree of liberality of construction of any of the claims in issue 1, 2 or 5 of this patent in suit No. 2,199,611, in order to cover the appellees’ accused devices could possibly *by that same construction* cover this Wright device.

Also the construction of the claims in issue of this patent in suit that is necessary for the appellees’ accused devices to be infringements of these claims describes a structure that not only is not anticipated by Wright *but*

also it represents clear invention over Wright, because it is a substantial advance over Wright.

The invention of this patent in suit represents a *substantial advance* over Wright because:

1. Wright does not have a plurality of outlet passages through the housing.

2. Wright cannot conduct steam separately to a plurality of steam operated devices.

3. Wright cannot operate a plurality of steam operated devices "*one at a time in sequence*" as specified in Claim 1 or "*in sequence, one after the other*" as specified in Claim 2 of this patent in suit No. 2,199,611.

4. Wright cannot operate a plurality of steam operated devices one at a time in sequence "*responsive to the downward movement of the float*" as specified in Claims 1 and 2.

On the other hand the structure invented by appellant and covered by the claims in issue of this patent in suit *can and does* accomplish all of these obviously new and beneficial results and so it constitutes a *substantial advance* over Wright, as well as over the rest of the prior art.

Therefore this patent in suit is a *substantial step* in the art over appellees' second "best reference" Wright.

II.

The Appellees' Asserted 1932 Installation at the Continental Lease at Seal Beach.

Appellee tried to invalidate the second patent in suit, No. 2,233,395, by attempting to prove an installation at Seal Beach, California on the lease of the Continental Oil Company of an alleged anticipating device. They may attempt to apply it to the first patent in suit, No. 2,199,611, so appellant will dispose of it here for both patents in suit.

This asserted 1932 structure was so weak and ineffectual that it is as if they had never tried to prove it.

Appellant will now review the proofs and reasons showing this.

(1) The Asserted 1932 Structure Was Never Proven as to What It Was so It Is Not Part of the Prior Art.

The Lower Court attempted to dispose of this issue with these words:

“It need not rise to mathematical certainty.” [R. p. 15.]

This was clear error. It was amplified by appellees in their 10th and 11th “finding of fact” [R. pp. 21 to 22] which the Lower Court obligingly signed for them. But these “findings” are in direct conflict with the appellees' own witnesses.

The record, on the other hand shows that though *something* was installed at Seal Beach in 1932 *no one knew the mechanical construction of what was installed.*

Taking first the so-called “conclusive” evidence of manufacture that was “found” to be “clear, satisfying and convincing beyond a reasonable doubt”—the witnesses Harvill, Beck and Robson *proved absolutely nothing* under the familiar and well-known rules for proving a prior use.

Harvill's testimony shows he knew *absolutely nothing* about the combination—he merely made some parts which could have gone into a pump governor, and he had no records. His testimony shows his total worthlessness as a "prior use" witness [R. pp. 163-169, incl.].

Q. You never saw this valve before today, this particular valve, did you? A. No, I never saw that before today. I might have made it. I don't know . . . This particular valve might have been one of those we machined up for Mr. Pinkerton, or it might have been made yesterday.

Q. By Mr. Jamieson: You don't know when this was made, then? A. I don't know.

Q. You have never seen any of these drawings before today, have you? A. No; I haven't . . .

Q. There was never any part like this on Exhibit E, the top part? A. No. These parts from here up we had nothing to do with . . .

Q. But you didn't see them assembled at the plant? A. No. I don't know anything about that.

Q. And you don't know what the full combination of any of his parts was? A. No; not of this valve here or anything that went on after it went out. I don't know anything about those . . .

Q. You don't have any records back of 1935 of any of these transactions referred to, do you? A. No; I haven't. I have changed organizations and moved around and my records got kind of bulky. I might find them if I looked . . .

Q. That is strictly a matter of your memory, in your memory? You haven't refreshed it from any written documents? A. No. . . .

Q. By Mr. Jamieson: And the parts you did make, as far as you did go, could have gone into a pump governor or any place? A. That is right." [R. pp. 163-169, incl.]

Beck was equally uninformed about details and he proved nothing that would establish a “prior use” under elemental principles of patent law [see R. pp. 175-176].

“Q. Do you know anything about the parts that go above the port? A. No.” [R. p. 176.]

Finally, Robson, the only remaining witness to “conclusively” prove manufacture of an anticipating device completely broke down on cross-examination, despite the efforts of the Court to help him [R. pp. 179-180].

“Q. Mr. Robson, you didn’t know what these parts were used for after they left your hands, did you? A. No; I didn’t.

Q. And you were just given a print and told to make one part and passed it on? A. No; I don’t think we had a print . . .

Q. When did you first see this particular part? A. I think I saw it only today.

Q. Have you seen any of these parts before today? A. I have seen that part in Pinkerton’s car over a week ago,—or something similar, but I couldn’t say it was the same one.

Q. The Court: Do you mean you have seen something of the same kind but not this particular one? A. Yes.

Q. By Mr. Jamieson: You don’t know what it is used for, do you? A. No.

Q. You don’t know what the complete assembly is? A. No.” [R. pp. 179-180, incl.]

This witness gave the real key to the whole 1932 story—he saw something in Pinkerton’s car a week before the trial and was asked to testify about it. Presumably the others did the same.

This brief review of the asserted "manufacture" shows how completely the appellees' proofs failed and how erroneous is the 10th "finding of fact" on page 21 of the record on this appeal.

The appellees' attempts to prove "prior use" were as deficient as their above attempts to prove "prior manufacture."

In the 10th finding of fact [R. p. 21] "disinterested witnesses" Brown, Thornton and Dolarheid are relied on to prove prior use. Their testimony was as ineffectual as that of Harvill, Beck and Robson, *supra*.

Brown *knew absolutely nothing about the mechanical construction or mode of operation of the assembly he was in charge of installing*, as shown by his testimony.

“Q. Did you have drawings of any kind on that job? A. I don't remember.

Q. Have you any drawings now that would show what was in that job? A. No.

Q. Were you in charge of the work? A. In charge of the installation; yes . . .

Q. What was inside of the cap? A. I wouldn't know.

Q. Do you remember what was on top of the cap? A. No; I don't recollect right off the bat. I don't know.

Q. I want what you remember. A. Well, I don't remember.

Q. Do you remember what was below the cap? A. No.

Q. Do you remember what was to the side of the cap? A. No; I don't.

Q. Do you remember what the cap—or the function it performed? A. If I have to give the answer from memory, I can't, but, if I do from my knowledge, I can answer.

Q. I want to know what you remember about it.

A. I don't remember whether I got my ideas on it or my knowledge of it from what I saw then or from what I have seen since as to the assembly that they have there . . .

Q. You don't remember what they looked like?

A. No, I don't. . . .

Q. Do you know whether there was a valve in it?

A. No, I don't know.

Q. Do you know whether there were any arms on the valve? A. Are we still talking about that assembly down there?

Q. I am talking about the one that you say was so installed down there at the company that you were employed by, on the date that you mentioned on direct, that particular installation? A. Do you mean that part of the installation?

Q. I don't care about these drawings but I want to know what you remember of your own memory of what was constructed down there at the Continental Oil Company lease, I think you said, prior to 1933. I want to know what parts you can remember of your own independent memory and what they did? A. I wish I knew just exactly what you want me to give you.

The Court: He is trying to test your recollection to see if you remember the device that you said you knew of at that time; that is all. A. That is asking an awful lot of memory.

The Court: He is not trying to show that you remember. He is trying to show that you don't remember. He is cross-examining you. . . .

Q. There were no valves in it, were there? A. I wouldn't remember that.

Q. There was no hand mechanism to operate, was there? A. I wouldn't remember that, either.

Q. There was no manual release? A. No, I wouldn't remember that.

Q. There were no slots in the valve stem? A. I didn't see that.

Q. There was no diaphragm in it? A. I wouldn't remember.

Q. There was no leather cup or packing? You wouldn't remember that? A. Why, no. A construction crew doesn't get into those details if it is not part of their work. . . .

Q. By Mr. Jamieson: Did you ever run low on water and have to use this equipment? A. No; not to my knowledge. . . .

Q. You didn't hear it operate? A. I wasn't there. . . .

Q. When the whistle worked, did the fuel shut off at the same time? . . . A. I don't know now; no . . .

Q. Did you ever hear the whistle blow after that? A. No." [R. pp. 188-196, incl.]

Thorton was merely a workman, working for Brown and he knew even less than Brown, as shown by a few excerpts from his testimony:

"Q. Do you know whether the valve had a valve stem on it? A. Well, I don't remember.

Q. Do you remember whether there were any slots in the valve stem? A. No, I don't remember how it was made that way.

Q. Do you know whether it had one or two valves. A. No; I don't know." [R. p. 203.]

Dolarheid, the last witness that was supposed to “*Conclusively*” prove a structure like the claims in issue of the patents in suit in this case knew no more than the others, as the following excerpts from his testimony show:

“Q. Did you see what the inside looked like? A. No; I did not. . . .

Q. Was there a leather cup? A. No.

Q. Was there more than one valve in it to operate it? A. I wouldn’t know.

Q. Do you know whether there were any stems on the valves? . . . A. I wouldn’t know.

Q. Do you know whether there were any slots in the valve? A. I would not know that, either.

. . .

Q. Did you see the inside of any of the mechanism? A. No.” [R. pp. 209-211, incl.]

The foregoing analysis of all of appellees’ evidence shows that it was *wholly ineffective*.

As this Court said in *Bianchi v. Barili*, 78 U. S. P. Q. 5 at page 12:

“But when it comes to identifying ‘the machine’ as the accused device, Cortopassi’s testimony is **WHOLLY INEFFECTIVE**. . . .

“Cortopassi admitted that he had made only part of the rollers, had never seen the machine in operation, had never seen a ravioli come out of it, and had never seen any cutters on the rollers.” (Emphasis added.)

In view of the foregoing appellant submits that it was a gross abuse of discretion and a flagrant error for the Court below to sign [R. p. 25] the findings of fact in this case without striking out findings 10 and 11 on pages 21 and 22 of the Record herein.

The only remaining witness, the appellee Pinkerton himself, couldn't establish a prior use.

In the first place his testimony doesn't establish it, as shown by the excerpts cited immediately below.

In the second place, even if Pinkerton's testimony had identified the parts, it would not be enough because the testimony of one witness, especially a defendant, cannot establish a prior use under the authorities cited below.

Appellee Pinkerton failed utterly to prove *what* was installed at Seal Beach in 1932 as shown by the following excerpts from his testimony.

He wouldn't even testify that he was present at the alleged installation [R. p. 261].

He admitted he has never made any effort to find the structure alleged to have been installed at the Continental [R. p. 262], and therefore there is no foundation for secondary evidence.

He admitted that even the structure alleged to be at Seal Beach did not have delayed or consecutive action like the patented and accused devices [R. p. 265].

Pinkerton admitted that he has no records of his alleged installation [R. p. 266].

Pinkerton admitted flatly that the drawing, Exhibit H [Book of Exhibits p. 324], does *not* show what was installed at Seal Beach [R. pp. 287-288, incl.].

Finally, the uncorroborated testimony of the defendant Pinkerton alone will not be sufficient to establish and prove prior use by oral testimony alone, particularly since he is the defendant.—Walker on Patents, Deller's Edition, Sec. 63 at page 304.

Searchlight Horn Co. v. Victor Talking Machine Co., 61 Fed. 395 at page 401:

“The proof of prior use by oral testimony should be scrutinized very carefully. At best such method

of proof is unsatisfactory. Forgetfulness, liability to mistakes, *the power of psychological suggestion, innate tendency to remember what those calling witnesses desire, possible bias, prejudice, interest, or perjury*, all suggest the wisdom of the rule requiring the defendants to prove prior use *beyond a reasonable doubt by clear and convincing testimony*.

“Every reasonable doubt should be resolved against one attacking the validity of a patent.

“The necessity of this rule is emphasized when the attack is based upon oral testimony alone of facts long past.”

National Hollow B. B. Co. v. Interchangeable B. B. Co., 106 Fed. 693 (C. C. A. 8), at page 703:

“The claim of the beam itself to antiquity rests on the testimony of ONE witness . . .

“The solemn grants of great franchises cannot be stricken down by testimony so flimsy and unsatisfactory.

“The memory of man is too brief and fleeting, too easily swayed by chance and by interest, to permit the recollection of ONE or two witnesses, prompted by presently prepared pictures of the proof desired to condition the validity of valuable patents that have stood unchallenged for years.”

Mast Foos & Co. v. Dempster Mill Mfg., 82 Fed. 327 (C. C. A. 8), at page 332:

“The evidence of prior use is the testimony of a SINGLE witness, who was once in the employ of another infringer of the device of the appellant, but has since been employed by the appellee.

“He produces no part of the old windmill which he testifies was set up and put in operation before Martin

filed his application, and *his evidence is without the support of any patents or exhibits, and without the support of the testimony of any other witness.*"

Therefore, appellant respectfully submits that this asserted 1932 "prior use" should be rejected *in toto* for failure of proof.

(2) It Was Not Pleaded.

The Lower Court said in its opinion:

"The use of the 1932 structure was not pleaded as a defense, and cannot be considered as anticipation. (35 U. S. C. S. 69(5); and see *Electric Battery Co. v. Shimadzu*, 1939, 307 U. S. 5, 17)." [R. p. 14.]

The vital importance of this is that the fact it was not pleaded shows it was *an afterthought*.

If Pinkerton had *really* installed an anticipating device *he would have remember it the moment this suit was filed.*

3) No Device Like the Asserted 1932 Structure Was Proved.

Appellant first thought of his device in 1932 or 1931 [R. p. 100] and he built the first one in 1933 and sold one in 1934 [R. p. 101], subsequent to October, 1933 [R. p. 103], to *Tippett Drilling Co.* in Louisiana [R. pp. 104-105].

He made his first sale in California in 1938 [R. pp. 3, 105] and then *after* that, in 1939, he first saw appellees' accused device [R. p. 94].

Appellee Pinkerton corroborated this in effect by his evidence admitting that he started the drawings for his accused device in 1938.

His employee Correze testified: that it was "the last part of 1938" as follows:

"Q. Now, I show you another photograph that is marked Plaintiff's Exhibit 13, and ask you if you can identify that (as) a Pinkerton construction. A. Yes, it is.

Q. What is it? A. It is a fuel cutoff valve.

Q. Do you know when Pinkerton started making that construction? A. Yes.

Q. When? . . . A. . . . the last part of 1938. . . .

Q. Does that look like the first job that he put out? A. I couldn't say whether that was the first one, or not. They all looked alike.

Q. You don't remember seeing any of them before the latter part of 1938, is that it? A. No. . . .

Q. And is the structure shown in Exhibit 11 exactly like that that you made the first drawings for in 1938? . . . A. Yes." [R. pp. 24, 229.]

Appellee Pinkerton admitted [R. p. 267] that he saw appellant's patented invention at least in 1938.

These are the first fuel shut off valves made by appellees as proven in the record. They were made late in 1938.

If, as appellees contend, the 1932 installation was successful why were no other devices like it ever made?

That appellee Pinkerton copied appellant's structure in 1938 is obvious from a mere comparison of the two devices, Exhibits 5 and 12. If the Court will simply manipulate Exhibits 5 and 12 a few moments it will see how Exhibit 12 was copied from Exhibit 5.

This is most persuasive evidence that the asserted 1932 installation never existed—except in appellee Pinkerton's mind—and then for the *first time just before this trial*.

Also if the asserted 1932 structure had been made the fact that no other was made is persuasive that it was at most an ABANDONED EXPERIMENT and hence not a part of the prior art.

Pickering v. McCullough, 104 U. S. 310, 319, 26 L. Ed. 749, 752;

Deering v. Winona, 155 U. S. 286, 39 L. Ed. 153, 159;

Electrical Co. v. Champion Switch Co., 23 F. 2d 600, 603 (C. C. A. 2);

Barbed Wire Case, 143 U. S. 275, 292, 36 L. Ed. 154, 161;

Morey v. Lockwood, 8 Wall., 230, 19 L. Ed. 339, 342;

Kirchberger v. American Co., 124 Fed. 764, 777;

Farmers Mfg. Co. v. Spruks Mfg. Co., 127 Fed. 691, 693;

In re Coykendall, 29 F. 2d 868, 869.

- 4) The Asserted 1932 Structure Was Not Capable of Achieving the Results of the Patents in Suit, and Therefore It Cannot Limit the Scope of Any of the Claims in Issue Herein, Under the Law.

The primary result achieved by the patents in suit was the new function of warning the boiler attendant by a whistle that if he didn't attend to the water supply the fuel would be shut off in a short period of time.

This object and result was fully described in the specification as pointed out hereinabove.

This result was achieved by the patented combination including the master control unit which caused the consecutive actuation of the whistle and fuel shut off valves.

This delayed action is not possible in the asserted 1932 structure and it is present in the accused structure, as the

appellee Pinkerton flatly admitted at the trial [R. pp. 273-275, incl., and p. 265]:

“Q. By Mr. Jamieson: In your structure that you are now making the fires are put out by shutting off the fuel valve, isn't that true? A. Yes.

Q. And that is shut off a period of time after the whistle blows, isn't that true? A. What does the word 'period' mean?

Q. You don't know what 'period' means?

The Court: A lapse of time is a period of time, any lapse of time is a period of time.

A. Yes, yes.

Q. By Mr. Jamieson: On the other hand, on this device that is not an infringement, this Exhibit E and F, they operate simultaneously, don't they? A. Yes.

Q. Is there an advantage in having a lapse of time between the operation of the whistle and the operation of the fuel cutoff valve? . . .

Q. *Do you consider that as an advantage?* A. Under the present condition, *yes.*” [R. pp. 273-275, incl.] (Emphasis supplied.)

This was amplified by appellee Pinkerton as follows:

“Q. Was that in the one down at Seal Beach? A. Yes.

Q. When you open that single valve it causes the steam to go simultaneously into those two openings, doesn't it? A. Yes.

Q. So there is no period of time between the operation of one valve or the other, is there? A. No.

Q. Is there any way that that could be operated to cause delayed action of the opening of one valve instead of the other? A. This valve here?

Q. Yes. A. No.

Q. The device that is accused and charged to infringe, as shown in your catalogue, however, is susceptible to that delayed action, isn't it? A. That is right." [R. p. 265.]

Thus, clearly, *the asserted 1932 structure cannot achieve the result.*

That such a structure cannot limit the scope of the claims of a successful patent like those in suit herein [R. pp. 86, 289], is a well established principle of law.

One Piece Lens Co. v. Stead, 274 Fed. 667 at page 670;

Pickering v. McCollough, 104 U. S. 310, 319, 26 L. Ed. 749 at page 752;

Deering v. Winona, 155 U. S. 286, 39 L. Ed. 153 at page 159;

The Barbed Wire Case, 143 U. S. 275, 292, 36 L. Ed. 154 at page 161;

Farmers Mfg. Co. v. Spruks Mfg. Co., 127 Fed. 691 (4th C. C. A.);

In re Coykendall, 29 F. 2d 868 at page 869.

5) **The Asserted 1932 Structure Adds Nothing to the Parker Patent No. 1,965,052.**

Parker is disposed of fully hereinafter under patent in suit No. 2,233,395.

T H A D A S I M U L T A N E O U S L Y A C T I N G W H I S T L E A N D F U E L V A L V E.

That is the most that appellees can claim for their 1932 structure. The model, Exhibit F-2, admittedly made later, shows a single valve with a passageway from the steam chamber through a "Y" shaped passage to a whistle and fuel shut off valve—thus actuating them *simultaneously*.

Appellant proved that this does not embody his invention by his testimony at the trial [R. p. 292]:

“Q. By Mr. Jamieson: Is the structure of your patent present in that structure that was described at the Seal Beach installation? A. No, it is not.

Q. Why not? A. Because the fuel cutoff valve and the whistle operate simultaneously from the pressure emanating from a single valve.” [R. p. 292.]

Thus the Record and appellees’ own admissions *completely belie* the following erroneous statement of the Court below in its “Memorandum Decision”:

“The accused devices, subsequent to 1932, are, *so far as the record shows*, substantially the same as,—*if not identical*,—with the former device.” [R. p. 16.]

Therefore, *on the merits*, this asserted 1932 structure has no place in this case.

Certainly this patent in suit, No. 2,199,611, is a *substantial step* in the art over appellees’ asserted 1932 structure.

Section Summary.

Appellant has fully demonstrated that this patent in suit, No. 2,199,611, is a substantial step forward in the art over Baldwin and Wright, appellees’ only “best references,” and over appellees’ asserted 1932 use, and therefore appellant is entitled to a sufficiently liberal interpretation of the claims in issue, Nos. 1, 2 and 5, of this patent in suit No. 2,199,611, to cover appellees’ accused structure, which is a clear infringement of even the *prima facie* scope of these claims in issue.

Therefore the lower Court’s ruling should be reversed by this Court and this cause should be remanded to the lower Court with instructions to the lower Court to enter a decree holding the appellees’ accused structure to be an infringement of this patent in suit No. 2,199,611.

POINT (4).

Claim 1 of patent in suit No. 2,233,395 is infringed by the defendants' accused structures shown in Plaintiff's Exhibits 8 and 9 and illustrated in Plaintiff's Exhibit 11.

CLAIM 1.

The following elements of claim 1 of patent in suit No. 2,233,395 are clearly shown in the drawings and described in the specifications, they were shown at the trial to be equally clearly present in appellees' accused structure [R. pp. 72-84] and appellees will not deny, and therefore they will admit that they are embodied in their accused devices:

- (a) "*In a safety apparatus for boilers the combination of*" [see patent in suit No. 2,233,395, spec. p. 1, col. 1, lines 1-2 and R. pp. 72 and 273].
- (b) "*A fuel supply conduit*" [see R. p. 72].
- (c) "*A valve in said conduit*" [see spec. p. 1, col. 2, lines 37-38 and R. p. 72].
- (d) "*Means for yieldingly holding said valve open*" [see spec. p. 2, col. 2, lines 17-18 and R. pp. 72-73].
- (e) "*A compartment*" [see spec. p. 2, col. 2, lines 12-14, 26, 32, 36 and 38-39 and R. p. 73].
- (f) "*A diaphragm*" [see spec. p. 2, col. 2, lines 13-17 and R. pp. 73 and 271].
- (g) "*A protective liquid for said diaphragm in said compartment*" [see spec. p. 3, col. 1, lines 18-32 and R. p. 73].
- (h) "*Connections between said diaphragm and valve*" [see 74 in Exhibit 9 and R. p. 74].
- (j) "*Manually operable means for relieving the fluid pressure on said diaphragm*" [see spec. p. 2, col. 2, lines 34-36 and R. pp. 74-75].

The appellees will contest only element (i) of this patent, and appellant will now show that this element is equally clearly present in the appellees' accused structure.

(i) "*Means for supplying fluid under pressure to said compartment for flexing said diaphragm and moving said valve to closed position.*"

The means for supplying fluid under pressure to the compartment 72 and closing the fuel shut off valve 75 that are shown and described in this patent in suit are the valve 13 in the master control unit which supplies the steam and line 25a. These means for supplying fluid under pressure to the compartment to close the fuel shut off valve were fully described by appellant at the trial [R. pp. 290-292] and they are fully described in the specifications [p. 2, col. 1, lines 2-9], which at the same time describe their mode of operation, function and result.

This is repeated in the specification at page 2, column 2, lines 19-29.

These are the "means" for supplying steam ("fluid under pressure") to the compartment for flexing the diaphragm and moving the fuel supply shut off valve to closed position, namely, (1) "valve 13 in the master control unit," which is so set as to open when the water level has receded below the point where the whistle has sounded, and (2) pipe line 25a.

Appellee sought below to limit these means to just the second part of them, namely pipe line 25a, to try to make them read on their asserted 1932 structure. But the specification and drawings show these means also include a master control unit set to operate *after* the water level has receded below the point where the whistle has sounded.

This is the whole point of the invention—a prod to the boiler attendant to make him go to work after the whistle has sounded and *before* the fuel valve is closed, shutting off the fuel.

That this is the object of this invention is shown by the object part of the specification of this patent in suit at page 1, column 1, lines 14-23.

All of these “means”—the master control unit, the previously operating whistle alarm valve and the pipe line 25a—are necessary to accomplish these objects.

It was error for the lower court to accede to appellees’ theory that these “means” were only the pipe line 25a in order to try to make the invention of this claim closer to their asserted prior art 1932 “Continental” structure.

This is a patent that is entitled to a *liberal construction*. This liberality of construction as often shows itself in a *narrowing* as in a *broadening* construction to save the validity of the patent and hold the defendant as an infringer.

Walker on Patents, Deller’s Edition, Section 241, at pages 1206-1207 and cases cited states that this liberality of construction accorded meritorius inventions as often shows itself in a *narrow* construction as in a broad one, and, where it becomes necessary to construe a claim *narrowly* to hold it valid and infringed, courts will give such a *narrow* construction if they can do so consistently with the language of the claim and of the description.

Finally, to prove that this is not just an accidental mention in the specification, the concept here in issue is stated at still another, or fourth, place in the specification, namely, at page 2, column 2, line 65, to page 3, column 3, line 4.

Thus, to state it succinctly, *claim 1* of this patent in suit, No. 2,233,395, is *limited* by this element and by the parts of the specifications to which it refers, *to a sequentially operated master control unit*.

This limitation is present in appellees' accused devices and it is *not present* in appellees' asserted 1932 "Continental" structure or in any of appellees' prior art patents.

This was proven at the trial by appellant as follows:

"Q. By Mr. Jamieson: Is the structure of your patent present in that structure that was described at the Seal Beach installation? A. No, it is not.

Q. Why not? A. Because the fuel cut off valve and the whistle operate simultaneously from the pressure emanating from a single valve." [R. p. 292.]

Limitation of the claim of this patent by the specification is conceded by the Lower Court [R. p. 12] to be proper and legal.

Appellant therefore admits that the above limitation is a part of the claim of this patent.

This claim, therefore, will be deemed to include the limitation of a sequentially operated master control unit hereinafter.

The 7th "Finding of Fact" in this case, set forth at page 20 of the record on appeal, says that this element "means for supplying fluid under pressure to said compartment" "must be read in the light of the specifications to include any conduit means such as pipe 25a shown in the Blanchard drawings." [R. p. 20.] It follows irrefutably that since this element "must be read in the light of the specifications" to include *one* element, namely, pipe 25a, it *must also* "be read in the light of the specifications quoted hereinabove to include the other necessary element, namely, the SEQUENTIALLY OPERATED MASTER CONTROL UNIT, which is just as important and just as much a part of the "means" as the "pipe 25a."

Turning to the appellees' accused structure it will be quite obvious that all of this structure is present, both in letter and in spirit, in appellees' accused structure.

Appellees' accused structure has a whistle valve and a master control unit, which operates the whistle valve when the water level has receded below the point where the whistle is desired to be sounded and then a pre-determined period later this master control unit allows fluid under pressure to move along conduit 25a to the compartment 72 to close this fuel shut off valve 75.

This is fully shown by appellant in his testimony on direct and on rebuttal at the trial [R. pp. 74, 77, 81-82 and 290-292]. Comparison of the description of these means in the specification of patent in suit, No. 2,233,395, as outlined hereinabove, under this element in the description of this patent in suit, and as testified at the trial at the above pages of the Record herein, with the appellees' structure shown at Figure 2 in the lower right-hand drawing of Exhibit 9 and at Figure 3 in the upper right-hand drawing of Exhibit 9, together with the cross-sectional view shown in Figure 2 in the lower right-hand corner of Exhibit 10, shows clearly the presence of these means, both in letter and in spirit, in the appellees' accused device.

As is seen in Figure 3 in the upper right-hand corner of Exhibit 9 the fluid under pressure is stored in the alarm body above the water on which the float 3 rests. When this water recedes and carries with it the float 3, at a pre-determined point in this recession the valve marked 15 in Figure 2 in the lower right-hand corner of Exhibit 10 is pulled off its seat, which is marked 13 in Figure 2 in the lower right-hand corner of Exhibit 10, and which is marked 15 in Figure 3 in the upper right-hand corner of Exhibit 9. Pulling this valve off its seat makes the steam from the space above the water in the alarm body go past this valve and its seat, through the passageway, marked 16 in Figure 3 in the upper right-hand corner of Exhibit 9, to the pipe 24 which leads to the whistle 26 shown in Figure 1 of the right-hand side of Exhibit 8. This pipe

24 is also shown at 11 in Figure 2 in the lower right-hand side of Exhibit 10.

Therefore when the water in the alarm body recedes still further, carrying with it the float 3 a predetermined distance, which appellee Pinkerton testified was about between $\frac{5}{8}$ and $\frac{3}{4}$ of an inch in his accused device [R. p. 272], a second valve, marked 16 in the drawing Figure 2 in the lower right-hand corner of Exhibit 10, is pulled off of its seat by the further lowering of the float 3 and the lever 20, leaving the seat 13 open and permitting the steam or fluid under pressure to leave the space in the alarm body above the water and proceed along the pipe 12 in Figure 2 in the lower right-hand corner of Exhibit 10 or the pipe 25a in Figure 3 in the upper right-hand corner of Exhibit 9. This fluid under pressure then progresses down pipe 25a shown in Figure 1 in Exhibit 8 to the top of the fuel cut-off valve 20 where it enters the chamber 72, as shown in Figure 2 in the lower right-hand corner of Exhibit 9. This pressure then moves against the member 73, which is the equivalent of the diaphragm, and moves it downward thus closing the valve 75 against its seat 76 with the help of its connection 74. This valve 75 is held against its seat 76 by the pressure in the chamber 72, which is retained there by the valve marked 16 in Figure 2 in the lower right-hand corner of Exhibit 10 remaining on its seat 13, thus holding the pressure in the chamber 9, the pipe 12 which is numbered 25a in the other drawings, and the chamber 72. This valve 16 is held on its seat by the elevation of the float when water is poured in. When valve 16 isn't on its seat the steam pressure in the alarm body above the water is great enough to pass down the passageway outlined, namely, space 9, pipe 25a or 12 to chamber 72, and this steam will hold the fuel shut-off valve 75 on its seat 76.

When water is fed into the boiler and its alarm body, which is connected to it, the level of the water will rise and it will carry with it the float and raise it to the position shown in Figure 1 in the upper right-hand corner of Exhibit 10 and in Figure 3 in the upper right-hand corner of Exhibit 9. This float and its attached arm and pin mechanism then hold the valve 16 on its seat 13 [See Figure 2 in lower right-hand side of Exhibit 10], thus acting to prevent the pressure from returning from the compartment 72 to its source of supply, the chamber above the water in the alarm body and the boiler.

This means is fully described in the specification and is shown in the drawings of the patent in suit, as was fully pointed out hereinabove under this element in the description of this claim of this patent in suit.

Also infringement of this element was fully shown by the appellant, Mr. Blanchard, on direct testimony and also on rebuttal in this case [R. pp. 43-84; 290-292].

Finally the appellee, Pinkerton himself, admitted that his structure has these infringing elements operating in substantially the same manner and producing substantially the same results as follows:

“As it (the float operated lever) starts down it first opens a whistle, as this valve starts to open, then as it drops down it catches this second lever, this boss with the hole in it. It can drop about five-eighths to three-fourths of an inch. It catches and opens that one, lets steam pressure go down through to the copper line leading to our fuel valve, and allows it to build up a pressure and close the fuel valve.” [R. p. 250.]

Later, on cross-examination, appellee Pinkerton corroborated and amplified this, pointing out that his structure did the same work as the Blanchard structure

and that the Pinkerton structure did nothing in addition to the work done by the Blanchard structure as follows:

“Q. If the second valve is hooked up to the fuel shut-off in your device, the lowering of the arm past the point where the first valve is opened to the point where the second valve is opened will not perform any additional function or work than closing the fuel shut-off valve, will it? * * * A. Yes, it will close it.

Q. It will close it? A. Yes.

Q. It doesn't do anything else besides close it?
A. That is all.

Q. So that the work that the second valve in your structure, Exhibit 12, does, and the work that the second valve in the Blanchard structure, Exhibit 5, is exactly the same, isn't it? A. I would say the job was the same, yes. * * *

Q. By Mr. Jamieson: The result is exactly the same? A. Yes.

Q. And the way that that result is accomplished is the same in both valves, isn't it? A. Yes.” [R. pp. 283-284.]

Therefore infringement of this element by the appellees' accused structure is clearly shown and admitted.

The appellee Pinkerton admitted the advantage of the inclusion of this element in the combination as shown at his testimony in the transcript as follows:

“Q. Is there any reason for having a time interval between the blowing of the whistle and the shutting off of the fuel valve? A. On drilling rigs, yes, because they have a constant attendant at the boilers. I mentioned a few moments ago if steam pressure drops down very much it is VERY IMPORTANT

on the drilling rig, as the water drops down a little bit, sounding an alarm as a warning signal to the fireman or engineer, it gives him time to correct his water level in the boiler before the water drops low enough to shut out his fires, which is *very dangerous* on a drilling rig.” [R. p. 250.]

What he obviously means is that it is “dangerous” for the well, not for the boiler, as the drill stem is liable to get stuck if the steam pressure gets too low.

The specifications and claims should be read liberally and not be construed with legalistic rigidity. They should be read to preserve to the inventor what he actually invented and not some monstrosity created by the defendant’s twisting and “interpreting” of the claims and specifications.

This Court stated the true rule in *Bianchi v. Barili*, 78 U. S. P. Q. 5 at page 9:

“In the first place, considerable latitude in semantics is permitted to an inventor. As was said in *H. J. Wheeler Salvage Co. v. Rinelli & Guardino* (D. C. N. Y.), 295 F. 717, 727, ‘a patentee has the right to use such words as to him best describe his invention, and they will be so construed as to effectuate that result.’

“Second, the specification and the claims of a patent are *not* to be construed with *legalistic rigidity*. Here, as elsewhere in the law, ‘the letter killeth, but the spirit giveth life.’ . . .

“‘The object of the patent law is to secure to inventors a monopoly of what they have actually invented or discovered, and it ought not to be defeated by a too strict and technical adherence to the letter of the statute, or by the application of artificial rules of interpretation.’” (Emphasis added.)

It is well to note at this point that claim 1 of Patent No. 2,233,395 does not include the limitation found in Claims 2 and 3 of that patent of "non-return means to prevent back flow of fluid from said compartment" 72.

The fact that this element is present in claims 2 and 3 but not in claim 1 prevents appellees from contending that this element of "non-return means" should be read into claim 1.

Instead, reading the patent "from its four corners," the difference between claim 1, which doesn't include "non-return means" and claims 2 and 3, which do contain that limitation, is that to infringe claim 1 it is not necessary that all of the fluid be retained in chamber 72 until released by manual release 78, but only that some fluid pressure remain in chamber 72 to be "relieved" by the manually operable means.

Certainly in appellees' accused structure even if some of the fluid in chamber 72 surged back or back and forth from the chamber 72 to the source of supply, enough pressure is left in chamber 72 to hold fuel shut off valve 75 against its seat 76 until manual release means 78 are opened.

The foregoing shows clearly that each and all of the elements of claim 1 of patent in suit No. 2,233,395 are present in the defendants' admitted structure.

To cut down space in this brief in compliance with the order of this court and to simplify the issues on this appeal, appellant hereby withdraws claims 2 and 3 of patent No. 2,233,395 from issue on this appeal.

It remains only to show that the clear *prima facie* infringement of claim 1 of patent No. 2,233,395 cannot be evaded by appellees because of any prior art cited by them in this case.

The Art Prior to Patent No. 2,233,395.

The prior art cited by appellees does not limit the claims of patent in suit No. 2,233,395 and the clear prima facie infringement of these valid claims is not avoided or evaded by any prior art references.

Appellant will first dispose of the prior art references selected by appellees at the trial as their "best references" [R. pp. 212 and 212a] and that will dispose of the remaining references cited by the appellees in their answer. None of this prior art in any way limits any of the claims of this patent in suit.

1. THE APPELLEES' BEST REFERENCES.

(1) Parker No. 1,965,052, issued August 3, 1934.

This Parker device does not have the elements of the claims of this patent in suit, it does not have the mode of operation of the claims of this patent in suit, and it is not designed to, nor is it adapted to, nor was it actually used to achieve or accomplish the results that are achieved by this patent in suit. This was proven at the trial [R. pp. 293-296].

The Parker device is not a "safety apparatus for boilers," but is a mere regulator to increase or decrease the amount of fuel. Also it was not designed nor intended to do the work of this patent in suit.

The differences between this patent in suit and Parker make Parker so remote as to not even affect this patent in suit.

No Master Control Unit to Effect Fuel Shut-off After the Water in the Boiler Has Fallen Below the Point Where a Whistle Has Sounded.

There is no master control unit in Parker to close the fuel shut-off valve after the water in the boiler has receded below the point where a whistle is sounded. This is perhaps the most essential characteristic feature of the invention of this patent in suit. It is stated fully in the objects of this patent in suit. It is described fully in the specification, it is shown in the drawings and it is included in all of the claims of this patent in suit, as it is the "means for supplying fluid under pressure to the compartment to close the fuel shut-off valve" in order to accomplish the sensational results that are accomplished by this patent in suit.

The lack of this master control unit to effect delayed action of a fuel shut-off valve after a whistle has warned the boiler attendant that if he doesn't take care of the water supply the fuel supply will be shut off is a fatal defect as a reference in this Parker patent as well as in all of the prior art patents. It is neither shown nor suggested in any prior art patent cited by the appellees or found by the Patent Office.

On the other hand, Parker serves to illustrate the failures and deficiencies of the prior art. Parker shows a whistle which is actuated when the water supply gets to a predetermined point and when this whistle is operated there is a *simultaneously* acting valve which will cut down the amount of fuel, or even temporarily shut it off. This fuel valve in Parker, however, works *simultaneously* with the whistle valve and there is no means suggested or shown for actuating the fuel valve *after* the water has receded below the point where the whistle is sounded.

The fuel control valve 34 and the whistle valve 27-28 operate *simultaneously* and *not consecutively*.

(2) SUTHERLAND No. 1,209,355 ISSUED DECEMBER
19, 1916.

This patent is also quite remote from this patent in suit and in no way constitutes any limitation on any of the claims of this patent in suit, as was fully shown at the trial [R. pp. 296-297].

Some of the essential characteristic features of this patent in suit which are not present in Sutherland and which therefore distinguish Sutherland from this patent in suit are as follows:

1. Sutherland is a "feed water regulator" and it is not a "safety apparatus for boilers." Therefore, Sutherland is neither designed nor intended to do the work of this patent in suit.

2. There is no "fuel supply conduit" in Sutherland and this is an element of all three claims of this patent in suit.

3. There is of course no fuel shut-off valve and no "master control unit" to consecutively supply fluid under pressure to a whistle valve and to a compartment to shut off a fuel shut-off valve after a lapse of time following the blowing of the whistle when the water reaches a dangerously low point in the boiler.

Sutherland neither suggests the need nor indicates the solution of that need furnished by this patent in suit.

4. Of course there is no manually operable means to relieve the pressure in a compartment so as to permit a fuel shut-off valve to be reopened after it is positively closed.

The fact that Sutherland has a float 42 and a line 32 leading to a chamber above a piston does not make Sutherland a relevant reference. There is no master control unit in Sutherland to actuate consecutively a whistle and

a fuel shut-off valve to closed position after the level of the water in the boiler has fallen from the point where the whistle is blown to a lower point.

Reading claim 1 of this patent in suit upon the appellees' accused structure, set forth in detail hereinabove, is not in any way impaired, lessened or interfered with by this Sutherland patent No. 1,209,355. There is no way that a Court could rightfully say that, though the claims of this patent in suit in their *prima facie* interpretation read clearly upon the appellees' accused structure, this *prima facie* interpretation of the claims in issue would also read on Sutherland and therefore it cannot be used to read upon the appellees' accused structure. Since this is not true there is no way that appellees can use Sutherland to evade the clear infringement of the claims in issue by their accused structure.

(3) HORRIDGE, No. 930,860—ISSUED AUGUST 10, 1909.

This Horridge patent will not enable appellees to evade the clear infringement of this patent in suit by their accused structure any more than the patent to Sutherland No. 1,209,355, disposed of hereinabove, as appellant showed at the trial [R. pp. 297-298].

Horridge is not a "safety apparatus for boilers" and it neither suggests nor shows the invention of this patent in suit. Horridge was not designed nor intended to accomplish the results accomplished by this patent in suit and in fact Horridge demonstrates the *forward step* in the art made by this patent in suit.

There is no fuel supply conduit shown or described in this Horridge patent and, therefore, of course, there is no fuel shut-off valve and, most important, there is no master control unit to actuate a fuel shut-off valve into closed position after a lapse of time following its actuation of an alarm whistle or after the water in a boiler

has receded below the point where the alarm whistle was sounded.

The elements of claim 1 of this patent in suit are absolutely missing from Horridge, there being no "manually operable means to relieve the fluid pressure."

The concept of this patent in suit simply is totally absent from Horridge, which shows merely a flow valve for regulating or controlling the flow of steam under pressure.

There is no master control unit to close a fuel conduit after a period of time has elapsed following its performance of another operation, such as blowing a whistle.

The absence of these features and of many of the elements of each of the claims of this patent in suit make it obvious that this patent to Horridge No. 930,860 cannot in any way limit the scope of claim 1 of this patent in suit, or enable the appellees to evade their clear infringement, by their accused devices of this patent in suit.

(4) SPILLER, No. 229,644—ISSUED JULY 6, 1880.

This is a steam pump regulator, neither designed nor intended to act as a fuel shut-off valve, or a "safety apparatus for boilers." There is no fuel supply conduit in this structure which has nothing to do with fuel supply, as was shown by appellant [R. p. 298].

This Spiller device is neither constructed nor intended to do the work of this patent in suit and it will not accomplish the new, pioneer and beneficial result achieved by this patent in suit.

Many of the elements of each of the claims of this patent in suit are completely absent from this Spiller structure. There is no "fuel supply conduit"; no "diaphragm," or equivalent thereof, and no "protective liquid

for said diaphragm in said compartment," to name a few familiar absentees.

Perhaps the most fatal omission from this, and the other prior art cited by the appellees, is that there is no master control unit to supply fluid under pressure consecutively to an alarm and then to a fuel shut-off valve compartment after the water in a boiler has fallen below the point where the alarm has been sounded. This basic feature of this patent in suit, namely, the *master control unit*, is neither suggested, shown nor described in this Spiller patent.

Another element of claim 1 of this patent in suit that is missing in this Spiller patent is "manually operable means for relieving the fluid pressure on said diaphragm."

This patent in suit has been held valid over Spiller but the lower court erroneously held in effect that Spiller imposes such a limitation on claim 1 of this patent in suit that Spiller prevents it from being infringed by the appellees' accused structure. If this Court will merely compare claim 1 of this patent in suit with Spiller No. 229,644, with the drawings of this patent in suit and with the appellees' accused structure, it will immediately see how erroneous is the decision of the lower court, and how unfounded is the appellees' position in this case. There is no way that Spiller can act as a sufficient limitation on claim 1 of this patent in suit to enable the appellees to evade the consequences of their infringing acts.

The holding of the Court below that this Spiller patent and the other patents cited by appellees limit claim 1 of this patent in suit so as to enable the appellees to

evade infringement by their accused structure is the real fundamental error of the Court below that is the basis of this appeal.

When the great advantages to the public of stopping these dangerous explosions which were destroying lives and property at an alarming rate is contemplated, and when the appellant is given the *liberal interpretation* to which he is entitled, it will be seen that this Spiller patent and the other art cited by the appellees should not be permitted to deprive the appellant of his just rights, and should not be permitted to enable the appellees to evade the consequences of their obvious and flagrant infringing acts.

General Conclusions on Appellees' "Best References" for Patent in Suit No. 2,233,395.

These four patents, Parker, Sutherland, Horridge and Spiller were selected by appellees in the Court below as their "best references."

None of these patents is designed nor intended to accomplish the result achieved by this patent in suit. Also, none of these patents suggests possible alteration to achieve these results.

These patents are no closer to the patent in suit than the art cited in the Patent Office. They are just the usual obsolete, abandoned experiments that are dug up by defendants in patent infringement suits to try to evade their *prima facie* infringement. Appellant believes that when this Court carefully considers these four patents, Parker, Sutherland, Horridge and Spiller, it will feel as does the appellant, that they are the usual and typical

outmoded prior art and that they do not in any way limit the scope of the claim in issue of this patent in suit.

There is no way that claim 1 of this patent in suit can be twisted to read upon any of these prior art references.

Even the lower court admitted this flatly, as follows:

“The claims here would not read upon any of the references or on the best references.” [R. p. 14.]
(Emphasis ours.)

Most important, the same interpretation of the claim in issue of this patent in suit that clearly reads upon and covers the appellees' accused structure, as set forth hereinabove, will not cover, or read upon any of these prior art references.

Therefore, the lower court erred in holding that this claim is not infringed by appellees' accused structure because of these prior art references.

Under the law, under the authorities and under the facts in this case, appellant is entitled to a *liberal construction* of the claim of this patent in suit, which may be qualified as a “primary” invention, because it represents a *substantial advance* in the art.

But even if the claim in issue of this patent in suit was deemed “secondary,” for any reason, it would still have ample scope and range to include the appellees' accused structure without treading on the toes of any of these references in the prior art cited by the appellees, namely, Parker, Sutherland, Horridge and Spiller. *Bianchi v. Barili*, 78 U. S. P. Q. 5, at page 6.

Appellees' Other References.

The other references cited are even more remote than these "best references." It is not necessary to consider these other or "worst" references, since the appellees' "best references" are so remote.

2. APPELLEES' ASSERTED 1932 USE.

In its "Memorandum Decision" at page 14 of the record on this appeal the lower court held that this asserted "1932 structure was not pleaded as a defense, and cannot be considered as anticipation. (35 U. S. C. S. 69(5); and see, Electric Battery Co. v. Shimadzu, 1939, 307 U. S. 5, 17). However, such use may, together with the prior art as disclosed by prior patents in the field, be relied on to show want of invention. Such use may prove lack of invention or limit its scope." [R. p. 14.]

The lower court then went on to hold the patents in suit valid, thus holding that they have "invention" over the asserted 1932 structure.

Appellees did not appeal from this holding and so the patents in suit are now clearly valid over this asserted 1932 structure.

The only remaining question is can this asserted 1932 structure limit any or all of the claims in issue herein sufficiently to enable the appellees to evade their clear *prima facie* infringement. Appellant's reply to this question is given in detail hereinabove under patent No. 1,99,611, but it may be summarized as follows:

1. The asserted 1932 structure is entirely different. It is like the Parker patent No. 1,965,052, disposed of

hereinabove, because it has a *simultaneous* acting alarm valve and fuel shut-off valve. *Therefore*, like Parker, this 1932 structure:

- (a) Will not meet or anticipate any of the claims in issue, and
- (b) Will not invalidate any of the claims in issue for lack of invention, and
- (c) Will not limit any of the claims to enable the appellees to evade their clear *prima facie* infringement.

For these reasons the asserted 1932 structure is no better than Parker—it is the same as Parker—a mere cumulative reference at most.

The 1932 structure has no *consecutive* or delayed action by a master control unit between the blowing of a whistle and the cutting off of a fuel valve.

For this reason the 1932 structure is no better than Parker.

2. Also the asserted 1932 structure *was never proven as part of the prior art*.

No witness could describe it. On cross-examination all the witnesses fell down, as was shown fully hereinabove.

Also the device itself was never produced—only some admittedly later sketches and devices which one witness, appellee Pinkerton himself, said “were like” the asserted 1932 structure.

3. This asserted 1932 structure was not capable of achieving the results of the patents in suit and, under the following authorities it could not limit the scope of any of the claims in issue.

Prior Art Incapable of Achieving Results of Patent in Suit.

These prior art devices are not capable of achieving the results of this patent in suit and every reasonable doubt should be resolved against appellees in their attempts to limit the claims of this invention.

The lower court in this case said quite unequivocally that the appellees' prior art devices are not capable of achieving the results of the patent in suit as follows:

"Essentially, they are different in that they do not achieve the primary purpose of the present patents." [R. p. 14.]

That prior art to be effective to limit the claim of a later invention must be capable of producing the result designed to be obtained by the later invention is clear from the authorities, such as *One Piece Bifocal Lens Co. v. Stead*, 274 Fed. 667, in which the court said at page 670:

"The law is that prior inventions or discoveries, relied on to . . . LIMIT THE CLAIM of a later invention, must disclose a method capable of producing the result designed to be obtained. As said in Coffin v. Ogden, 18 Wall. 120, 21 L. Ed. 821, the burden of proof rests upon the defendant to show that the invention relied upon as the defense was CAPABLE OF ACHIEVING THE RESULT, and every reasonable doubt should be resolved against it." (Emphasis ours.)

As was said in *Smith v. Snow*, 79 L. Ed. 283 at page 90:

"The character of the patent and its commercial and practical success are such as to entitle the inventor to broad claims and to a liberal construction of those which he has made."

Section Summary.

Appellant has fully shown that the adjudicated valid claim in issue of this patent in suit No. 2,233,395, is infringed by the appellees' accused structure and is not limited by the prior art.

Therefore the erroneous decree of the lower court holding that the appellees' accused structure does not infringe this patent in suit should be summarily reversed by this Court of Appeals and this cause should be remanded to the lower court with appropriate instructions to enter a decree holding the appellees' accused structure to be an infringement of this patent in suit No. 2,233,395, as well as an infringement of patent in suit No. 2,199,611.

Conclusion.

Wherefore, appellant prays that the Judgment, Findings of Fact and Conclusions of Law appealed from herein be reversed and that said District Court of the United States for the Southern District of California be ordered to enter a Decree and Judgment reversing the Judgment appealed from and be ordered to enter a decree in favor of the plaintiff in this cause as prayed for in the appellant's Complaint herein.

Respectfully submitted,

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